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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,195	02/11/2004	Daniel Willis	165-05 US CIP	1626
25319 7590 07/09/2007 FREEDMAN & ASSOCIATES 117 CENTREPOINTE DRIVE SUITE 350 NEPEAN, ONTARIO, K2G 5X3 CANADA			EXAMINER OMOTOSHO, EMMANUEL	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 07/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,195

Applicant(s)

WILLIS, DANIEL

Examiner

Emmanuel Omotosho

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the at least a storage medium" in the last paragraph. There is insufficient antecedent basis for this limitation in the claim.

Drawings

3. The proposed drawings (Fig 1 and 2) are unclear. For example, the examiner is unsure as to what type of relationship/connections the applicant is trying to convey in fig 1. The labels are also unclear. In regards to fig 2, the element between element 150 and 140 is unclear.

Information Disclosure Statement

4. The applicant's field of endeavor, *Gaming system incorporating a set-top box*, contains numerous prior arts pertinent to what is currently being claimed. The examiner is uncertain as to why there is no IDS entry from the applicant. In addition to the next response, the applicant is highly encouraged to put on record pertinent references.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-2 rejected under 35 U.S.C. 102(b) as being anticipated by Yamada US Patent No. 6,929,549 B1.

Yamada discloses a digital television set system comprising:

7. Claim 1: a receiver for receiving digital television signals from at least a communication channel and a gaming console for use as a gaming client, the gaming console connected to the receiver (Par 7 lines 8-19, 40-46). A volatile storage memory for having stored therein client instruction data relating to a gaming client and game instruction data relating to a current game in execution (Par 23 line 63- Par 24 line 24, Par 24 lines 19-24). An external storage medium reading circuit for sensing for sensing data from an external storage medium and for storing the received data in the at least a volatile storage medium (Par 14 lines 34-40, Par 23 line 63- Par 24 line 24, Par 24 lines 19-24). At least a processor in communication with the at least a volatile storage medium, the processor for retrieving game instruction data therefrom for executing a game on the gaming console, and for retrieving client instruction data therefrom for executing a gaming client function on the gaming console wherein when set-top client instruction data and set-top application instruction data are stored in the at least a storage medium and are executed on the at least a processor, the gaming console emulates a set-top box for use in displaying video information extracted from digital television signals (Fig 3-5, 8-11).

8. Claim 2: an external local storage medium wherein the client instruction data and game instruction data are loaded from the external local storage medium into the at

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least a volatile storage medium (Par 13 lines 42-50, line 65 – Par 14 line 6, Par 15 lines 9-42 and Par 8 lines 59-63).

9. Claim 5: a transceiver for establishing a connection to a broadband access network (Par 3 lines 9-19).

10. Claim 6: a gaming console being part of digital television set system and coupled to a receiver for receiving digital television signals from at least a communication channel, the gaming console comprising at least a processor and at least a storage medium, and being in connection with a monitor and a sound system (Par 7 lines 8-19, 40-46,). Receiving first instruction data from an external storage medium read by the gaming console and including one of set-top instruction data for receiving and decoding digital broadcast data when executed on the gaming console and communication data for use in retrieving via the receiver the set-top instruction data for receiving and decoding digital broadcast data when executed on the gaming console (Par 9 lines 4-11, Par 10 lines 20-31). Executing the set-top box instruction data on the gaming console, receiving encoded digital broadcast data via the receiver, decoding the received, encoded digital broadcast data and displaying the decoded digital broadcast data on the monitor and on the sound system (Par 10 lines 20-52).

11. Claims 7-8: the set top instruction data are received from the receiver and an external storage medium in connection with the gamin console (Par 10 lines 20-31)

12. Claim 9: receiving a conditional access module and verifying access authorization for encoded digital broadcast data with the conditional access module (Par 25 lines 17-23).

13. Claim 10: wherein the access authorization is verified using authorization data provided from a smart card, the smart card in connection with the gaming console through an interface (Par 25 lines 17-23).
14. Claim 11: encoded digital broadcast data are scrambled, encoded digital data (Par 9 lines 32-37).
15. Claim 12: the scrambled, encoded digital broadcast data is descrambled by the conditional access module before being decoded (Par 14 lines 46-54).
16. Claim 13: wherein the gaming console is in communication with a monitor and is emulating a set top box for receiving and displaying on the monitor, services other than gaming services (Par 25 line 62- Par 26 line 9).
17. Claims 19-21: wherein the services relate to digital television broadcast, transmission control protocol/internet protocol access, or interactive television applications (Par 25 line 62- Par 26 line 9).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada.

21. Claims 3-4: Yamada fail to specifically disclose that the external storage medium is a compact disc/removable read-only memory cartridge. Applicant did disclose that choosing a compact disc/removable read-only memory cartridge as the memory medium for an external local storage medium provides an advantage, used for a particular purpose or solves a stated problem. Yamada teaches that the information is capable of being stored on a removable memory (Par 14 lines 62-67). Therefore, the examiner views this limitation of choosing between different types of memory mediums as a mere design choice well within the skill set of an ordinary skilled artisan.

22. Claim 14: Yamada teaches wherein the monitor is a monitor included in an analog transmission television set for a gaming machine with an analog transmission television set (Par 21 lines 45 - 67)

23. Claims 15-18: In the second embodiment, Yamada teaches that the gaming console is in communication with at least another network such as a community antenna television network, a telephone line network or a wireless network to solve the problem of the obstructive connection of the devices in the first embodiment (Par 25 line 62- Par 26 line 9, Par 17 lines 53-62).

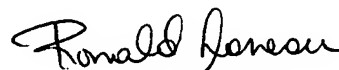
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO


RONALD LANEAU
PRIMARY EXAMINER
7/6/07